

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Steven Lundberg	Examiner:	Vivek Koppikar
Serial No.:	10/710,556	Group Art Unit:	3626
Filed:	July 20, 2004	Docket No.:	684.001US5
Customer No.:	21186	Confirmation No.:	4363
Title:	SYSTEM AND METHOD FOR SEPARATE CHARGES TO A LAW FIRM FOR EACH OUT-OF-POCKET COST		

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Applicant respectfully requests review of the Final Rejection in this patent application. No amendments are being filed with this request, which is being filed with a Notice of Appeal. Claims 1-54 are pending in this patent application.

§103 Rejection of the Claims

Claims 1-54 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Maue ("How to Control Your Company's Legal Costs") in view of Walker (U.S. Patent No. 5,970,478), in further view of Loeb (U.S. Patent No. 6,360,209, and in even further view of Landry (U.S. Patent No. 5,649,117).

Applicant respectfully submits that there is no *prima facie* case of obviousness in relation to claims 1-54 because the cited references, alone or in combination, fail to disclose all elements of the present claims.

Applicant cannot find in the cited portions of Maue, Walker, Loeb, Landry, or the reasoning set forth in the Office Action any disclosure of separate charges assessed for each of the plurality of out-of-pocket costs, as currently recited or incorporated in independent claims 1, 6, 11, 16, 21, 26, 31, 36, 41, 46, and 51-54.

Further, Applicant cannot find in Maue, Walker, Loeb, Landry, or the reasoning set forth in the Office Action any disclosure of determining each separate charge prior to invoicing the client for the out-of-pocket cost, as currently recited or incorporated in independent claims 1, 6, 11, 16, 21, 26, 31, 36, 41, 46, and 51-54.

In rejecting the claim limitations (1) separate charges assessed for each of the plurality of out-of-pocket costs and (2) determining each separate charge prior to invoicing the client for the out-of-pocket cost, the Office Action relies on Loeb, column 4, lines 47-62, which states:

As discussed further below in conjunction with FIGS. 9 through 11, a customer **10** who purchases multiple cancelable items as part of a single transaction or order from a merchant **20** will be separately billed on a credit card for each individual good or service in accordance with a payment schedule designed according to a feature of the present invention to minimize cancellation of the overall order by the customer **10**. According to a further feature of the present invention, the billing descriptor which ultimately appears on the credit card billing statement of the customer **10** will have sufficient detail to minimize the likelihood that the customer **10** will subsequently contact the merchant **20** to investigate the source of the charge. In one preferred embodiment, the billing descriptor will include a different customer service number for each individual item so that the customer **10** cannot cancel the entire order with a single telephone call.

(Loeb, col. 4, lines 47-62.) This section of Loeb discusses methods of separately listing on a bill individual items in order to prevent the customer from canceling an entire order. More broadly, Loeb discloses a method and system that permits multiple items purchased as part of a single transaction or order to be separately billed on a credit card in accordance with a payment schedule designed to minimize inquiries regarding the overall order by the customer. (See Loeb, Abstract.) Loeb appears to be focused on allowing merchants to provide credit card customer's itemized bills listing each item purchased in a single transaction, instead of the more typical single line item indicating the total amount with no detail regarding what was purchased.

In contrast, Applicant recites and claims assessing separate charges for each of the plurality of out-of-pocket costs, where the separate charge is associated with, for example, a finance charge or loan fee in addition to the price of the out-of-pocket cost. Even if Loeb's "items" are analogous to Applicant's "out-of-pocket costs," an assertion to which Applicant respectfully disagrees, Loeb does not disclose any "separate charges assessed for each" item in addition to the cost of the item itself. In fact, the Loeb reference contains no references to additional charges, fees, interest or any other form of transaction cost that could be associated with each of the billed items and charged to the customer.

Additionally, Applicant cannot find in Loeb any disclosure of "determining each separate charge prior to invoicing the client for the out-of-pocket cost." Loeb does appear to disclose

breaking up a multiple item order into individual items prior to invoicing. However, as discussed above, Loeb contains no discussion of determining separate charges related to individual items; hence it is not possible for Loeb to disclose determining these separate charges prior to invoicing.

The Office Action takes the position that “each individual service will then include the finance charge associated with the service along with the actual price of the service.” (Office Action at 3.) However, as discussed above, Loeb includes no discussion regarding finance charges associated with the items (goods and services) invoiced. Due to the lack of support for this assertion in Loeb, it appears as if the Examiner wishes to take “official notice” with regard whether each individual item includes a finance charge. Applicant traverses any such assertion and requests that the Examiner provide an affidavit or other evidence supporting the noticed fact, as required by M.P.E.P. § 2144.03. Additionally, even if the cited combination of references did disclose a separate charge, which Applicant respectfully submits they do not, they speak in terms of interest charges which are not “determined prior to invoicing” as recited and claimed by Applicant.

In sum, because Maue, Walker, Loeb, Landry, or the reasoning set forth in the Office Action, alone or in combination, fail to disclose all elements recited or incorporated in claims 1-54, Applicant respectfully submits that there is no *prima facie* case of obviousness with respect to claims 1-54. Therefore, Applicant respectfully requests reversal of all bases of rejection of these claims.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's representative at (612) 371-2174 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(612) 371-2174

Date

Nov 18, 2008

By

Ed J. Sandor

Edward J. Sandor
Reg. No. 60,824

CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 18 day of Nov, 2008.

John D. Gustav-Wrathall
Name Paralegal
Schwegman, Lundberg & Woessner

Signature

John D. Gustav-Wrathall